

REMARKS

The rejection of Claims 1-7, 9 and 10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is respectfully traversed.

The Examiner continues to find that the term “microfine fiber (B) having an average fineness equal to or less than that of the microfine fiber (A) but 1/1.76 or more than that of the microfine fiber (A)” does not comply with the written description requirement.

In reply, Applicants describe the following in the specification, beginning at page 6, line 24:

An excessively large difference between the average finenesses of the microfine fiber (A) and the microfine fiber (B) may cause nonuniform dyeing of the final suede-finished leather-like sheet. Therefore, it is preferred for the average finenesses to satisfy the following formula (9):

$$0.1 \times A < B < A \quad (9)$$

wherein A is the average fineness of the microfine fiber (A)  
and B is the average fineness of the microfine fiber (B).

As a matter of elementary algebra, upon dividing formula (9) by A, the following formula (9') is obtained.

$$0.1 < B/A < 1 \quad (9').$$

Formula (9') means that the fineness ratio between the microfine fibers (B) and (A) is preferably 0.1 to 1.

An excessively large difference between the average finenesses of the microfine fiber (A) and the microfine fiber (B) results in a smaller ratio of B/A. Clearly, one of ordinary skill in the art would readily recognize that a larger ratio B/A within the range of 0.1 to 1 would be more preferred.

The Examiner acknowledges that the example in the specification (Example 1) provides a ratio B/A of 1/1.76, but then finds that Applicants “never acknowledges the ratio of these fibers or suggests that fibers systems with a similar ratio would be desired in the

present invention. And while the two fibers have the claimed ratio, the example in no way provides support for any other combination of fibers with a fiber fineness ratio such as 0.032 and 0.0182. The ratio encompasses not only the two fibers provided in the example, but also a wide range of fiber combinations which are not taught or suggested by the two specific fiber sizes. The ratio represents a genus of fiber combinations which includes the two fiber sizes disclosed by the example as a specific species within the genus. And just as a teaching to a species is not considered to suggest or teach the entire genus, the teaching of the two specific fibers sizes in the example cannot be used to teach the entire combination of two fiber systems represented by the ratio of 1/1.76.”

In reply, and as noted above, the specification clearly describes that the ratio B/A is preferably 0.1 to 1. The ratios 0.032 and 0.0182 are outside this range. In addition, by describing that an excessively large difference between the average finenesses of the microfine fiber (A) and the microfine fiber (B) is, in effect, problematical, as discussed above, the specification **is** addressing the significance of the **ratio**.

By combining the ratio B/A of 1/1.76 and the above teaching that a larger ratio B/A within the range of 0.1 to 1 is more preferred, one of ordinary skill in the art would readily recognize that a ratio B/A of 1/1.76 (= 0.57) to 1 is described.

Apparently to emphasize her position, the Examiner finds that “[f]urther, it is noted that the claimed range is not just 1/1.76, but 1/1.76 *or more* (Examiner’s emphasis). There is no teaching or suggestion within the specification that the ratio of the fibers in the example is a desired minimum ratio of the two fiber sizes. The example provides no teaching with respect to fiber combinations having ratios lower than this ratio or fiber combinations having ratios higher than this ratio. It is completely silent to any other specific combination of fibers. Thus there is no support for the *or more* portion of the limitation in combination to the ratio of the fibers.”

In reply, and as noted above, however, the specification clearly describes that the ratio B/A is preferably 0.1 to 1. Thus, the Examiner's view that "it is completely silent to any other specific combination of fibers" is improper. Also as noted above, the specification teaches that a large difference between the finenesses, i.e., a smaller ratio B/A is not preferred. Thus, the specification suggests that a larger ratio B/A within the range of 0.1 to 1 is preferred. Clearly, the specification well supports the "or more" portion of the limitation.

In reply to Applicants' arguments in the previous response, beginning at the paragraph bridging pages 3 and 4 of the Office Action, the Examiner finds that "[f]irst, the equation does not compare ratios of the two fiber sizes, but just provides a limit on the absolute fiber size of microfiber B."

In reply, the only explanation for the Examiner's finding is misinterpretation of the meaning of formula (9):  $0.1 \times A < B < A$ . As noted above, formula (9) is equivalent to formula (9'):  $0.1 < B/A < 1$ . Contrary to the Examiner's finding, formula (9) does not provide a limit on the absolute fiber size, but provides a limit on the ratio of the two fiber sizes.

In addition, and as pointed out in the previously response, applicable case precedent does not require that Applicants appreciate the importance of a particular limitation, or that such a limitation be required. All that case precedent requires is that Applicants have possession of the presently-claimed invention as of the filing date. It is well-established that amending an endpoint of an originally-recited range by reference to a particular example in the specification complies with the description requirement. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (copy of record).

The Examiner finds that *Wertheim* is, in effect, inapposite. The Examiner basis is that Applicants are "not simply choosing a value from within a specific range."

In reply, that is precisely what Applicants are doing, as explained above.

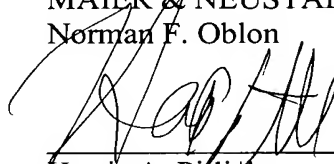
For all the above reasons, it is respectfully requested that the rejection be withdrawn.

All of the presently-pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'H. A. Pitlick', is written over a horizontal line.

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